

REMARKS

Applicant respectfully requests reconsideration of this application as amended. No Claims have been amended. The claims presented are in better form for allowance and for possible consideration on appeal. Applicant respectfully requests the Examiner to accept the proposed response. No Claims have been cancelled. No new claims have been added. Therefore, claims 1-19 are now are presented for examination.

35 U.S.C. § 103 Rejection

Claims 1-3 and 11-12 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Reilly, U.S. Patent No. 6,427,164 (“Reilly”) in view of Salzfass et al., U.S. Application No. 2002/0042815 (“Salzfass”).

Claim 1 recites:

1. A method for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list having multiple destination addresses for respective members, comprising: receiving a document by a document distribution server; recording in a database a document identifier and the distribution list; distributing the document to said members of the distribution list; receiving, in response to distributing to a first member of the distribution list, an error message comprising the document identifier; looking up the document identifier in the database so as to identify the distribution list; and automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages. (emphasis provided)

Reilly discloses “[s]ystems and methods for automatically determining the recipient of electronic mail that is unknown at the receiving server has left a ‘forwarding address’ . . . thereby allowing . . . to automatically *send the electronic mail content to the*

correct new address. In addition . . . the sending user is notified as to the new electronic mail address so as to allow the sending user to update manually, or automatically, the user's individual database of electronic mail addresses" (Abstract). Reilly discloses determining whether a *forwarding address is left* so that the *sending user can be notified and the database of electronic email addresses can be updated*. Reilly's use of the *forwarding address, notifying of the sending user, and then updating of the database* not only does not disclose or reasonably suggest automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages, it teaches away from claim 1. In light of Reilly's irrelevance, any teachings of Salzfass are also irrelevant, as there is no motivation to combine the two references. Hence, Reilly and Salzfass, neither individually nor combined, teach or reasonably suggest all the limitations of claim 1. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 1 and its dependent claims.

As with claim 1, Reilly does not teach or reasonably suggest the limitations of claims 8, 11 and 17. For example, claim 8 recites "looking up the document identifier of said error message in the database so as to identify the distribution list; and deleting the nonexistent member from the distribution list" (emphasis provided). Reilly's use of the *forwarding address, notifying of the sending user, and then updating of the database* is not the same as looking up the document identifier of said error message in the database so as to identify the distribution list; and deleting the nonexistent member from the distribution list, as recited by claim 8. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 8 and its dependent claims.

Claims 11 and 17 contain limitations similar to those of claims 1 and 8.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 11 and 17 and their dependent claims.

Claims 4-10 and 13-19 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Reilly, in view of Salzfass, and in further view of Applicant's prior art.

Claim 4-10 and 13-19 depend from one of claim 1, 8, 11 and 17 and thus include all the limitations of their base claim.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

Request for an Extension of Time

Applicant respectfully petitions for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17(a) for such an extension.


Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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